



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: Russell L. Miller et al.)
Serial No.: 10/817,559) Examiner: NOT YET ASSIGNED
Filed: April 2, 2004) Group Art unit: 1745
For: BATTERY RACK AND SYSTEM) Docket No.: D1243 1010.1
) Confirmation No.: 3797

PETITION TO FILE ON BEHALF OF INVENTOR
REFUSING TO SIGN (37 CFR §1.47(a))

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Petition is hereby made requesting the Commissioner to accept the accompanying declaration for the above-identified application, which declaration has been filed omitting the signature of inventor ANDREW MARRAFFA (“Mr. Marraffa”). It is requested that the original filing date and serial number be maintained, as identified above.

The omitted inventor, through his employer, has refused to join in the application and has refused to sign the Declaration.

The pertinent facts are as follows. Mr. Marraffa is an employee of Kim Manufacturing Company of Downingtown, Pennsylvania. On November 20, 2001, Mr. Marraffa filed a nonprovisional U.S. patent application (Serial No. 09/989,502) for a Battery Rack and System. The nonprovisional application claimed priority to provisional application Serial 60/294,444, filed May 30, 2001. Specifically, the nonprovisional application was directed to a frame device for supporting batteries during a seismic event. Mr. Marraffa was listed in the application papers as the sole inventor. The nonprovisional application matured into U.S. Patent No. 6,719,150,

issued April 13, 2004 and was assigned to Mr. Marraffa's employer, Kim Manufacturing Company.

Applicants Russell Miller, Henry Jarrett, and David Vutetakis of the present pending application Serial 10/817,559 are employees of Douglas Battery Manufacturing Company of Winston-Salem, North Carolina. Applicants' employer has had a commercial relationship with Kim Manufacturing Company and Mr. Marraffa worked with Applicants listed above in the development of the design for the Battery Rack and System before Mr. Marraffa's filing of the nonprovisional application. In early 2004, the applicants became aware that Mr. Marraffa had filed the nonprovisional application, and subsequently obtained a copy of U.S. Patent Application Publication US2002/179552, dated December 5, 2002.

On April 2, 2004, the applicants filed a Continuation application (Serial 10/817,559), claiming priority to pending application Serial 09/989,502. Contemporaneously therewith, Applicants filed a Preliminary Amendment with new claims, fully supported by the pending parent application, directed to a battery rack assembly. An unsigned declaration was also submitted with the application papers, naming Mr. Marraffa as a co-inventor. Applicants subsequently received a Filing Receipt and Notice to File Missing Parts of Nonprovisional Application, both dated June 22, 2004. Applicants Miller, Jarrett, and Vutetakis each signed and dated the declaration on August 18, 2004.

On September 7, 2004, the undersigned, counsel for Douglas Battery Manufacturing Company, wrote to Mr. Marraffa and to Mr. Eugene E. Renz, Jr., counsel for Kim Manufacturing Company, to inform them of the Continuation application. It is believed that the correspondence included the complete application with the Preliminary Amendment. In that correspondence, Mr. Marraffa was asked to sign and return the declaration. Mr. Marraffa never responded.

On September 21, 2004, counsel for Douglas Battery Manufacturing Company wrote to Mr. Renz, emphasizing that the Continuation application should be jointed owned by Kim

Manufacturing Company, by assignment from Mr. Marraffa, and Douglas Battery Manufacturing Company, by assignment from Messrs. Miller, Jarrett, and Vutetakis.

On October 28, 2004, counsel for Douglas Battery Manufacturing Company wrote to Mr. Renz, providing another copy of the Preliminary Amendment filed April 2, 2004 in case the first copy was misplaced or not received, with a copy to Mr. Marraffa. Based upon the September 7, 2004 and October 28, 2004 letters, Mr. Marraffa was had complete knowledge of the subject matter of the Continuation application.

On November 30, 2004, in an e-mail attachment, Mr. Thomas J. Kiely, President of Kim Manufacturing Company, wrote to the counsel for Douglas Battery Manufacturing Company. In his letter, Mr. Kiely stated that Mr. Marraffa had repeatedly affirmed that he was the sole inventor of the subject matter of U.S. Patent No. 6,719,150. Mr. Kiely further stated that Mr. Marraffa would not be executing any documents to the contrary. Since the letter from Mr. Kiely is distinctly labeled as "Confidential—subject to settlement negotiations privilege," a redacted version copy of the letter is attached hereto.

Mr. Marraffa's last known address is: 513 Preston Court, Exton, Pennsylvania 19341.

Mr. Marraffa's business address is: Kim Manufacturing Company, 147 N. Wallace Avenue, Downingtown, Pennsylvania 19335.

Please provide a Four-Month Extension of Time up to and including December 22, 2004 to respond to the Notice to File Missing Parts of Nonprovisional Application as provided for in 37 CFR 1.136.

This petition is accompanied by:

- the patent declaration signed by all other co-inventors,
- a power of attorney,
- the petition fee of \$130.00,

- a copy of the Notice to File Missing Parts of Nonprovisional Application, along with surcharge of \$130.00, and
- an Extension of Time fee (4th Month) of \$1,590.00.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statement and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Favorable consideration of this petition is hereby courteously requested.

12-22-04
Date

Respectfully submitted,


C. Robert Rhodes
Attorney for Applicant
Registration No. 24,200

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P.O. Box 7037
Atlanta, GA 30357

Rhodes, Bob

From: Tom Kiely [tk@kimmfg.com]
Sent: Tuesday, November 30, 2004 2:15 PM
To: Rhodes, Bob
Subject: Kim Mfg / Douglas

The attached document contains a proposed resolution to your prior communications.

Thomas J. Kiely
President
Kim Manufacturing Co.

Kim Manufacturing Company

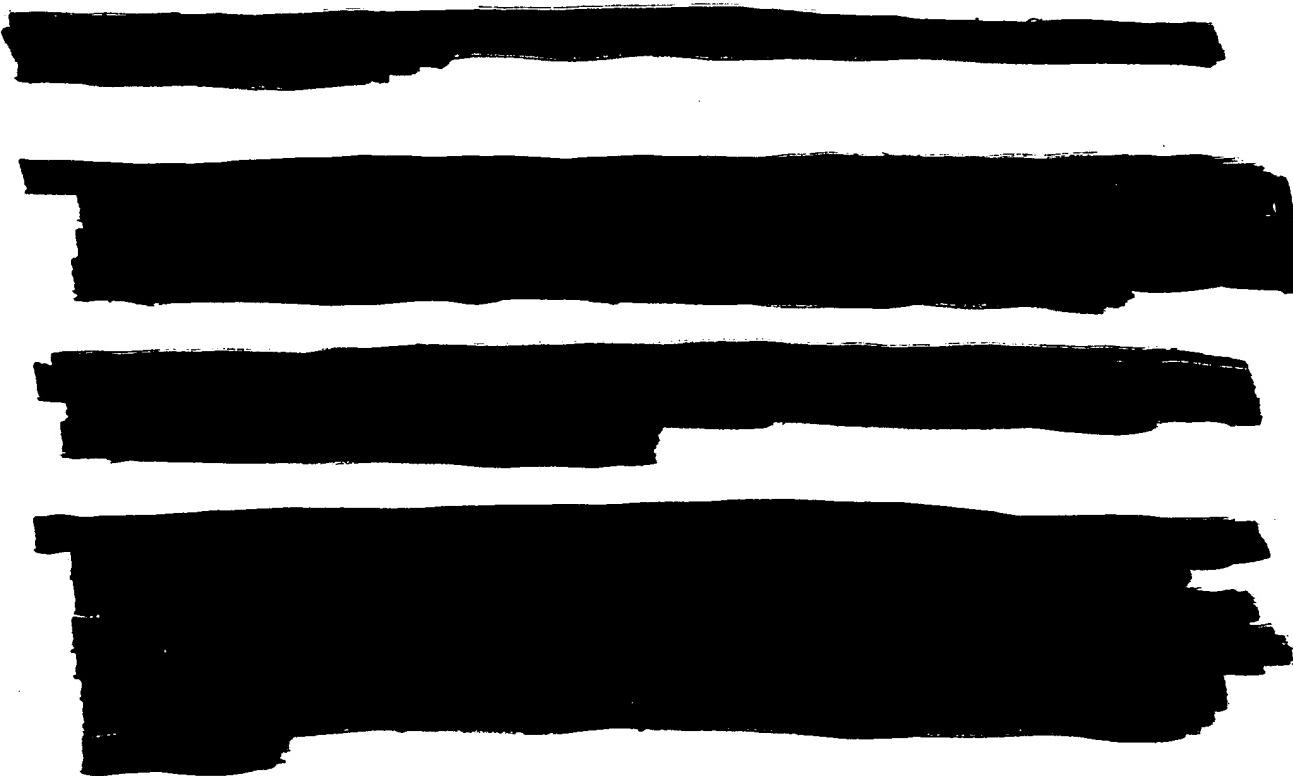
Confidential-- subject to settlement negotiations privilege

C. Roberts Rhodes, Esquire
Womble, Carlyle, Sandridge & Rice
300 N. Greene Street
Greensboro, NC 27401

Re: U.S. Patent 6,719,150 & Continuation

Dear Mr. Rhodes:

This is in response to your letter of September 21, 2004. Please be advised that Andrew Marraffa, Kim Manufacturing Company's Director of Engineering, has repeatedly affirmed that he is the sole inventor of the subject matter claimed in U.S. Patent 6,719,150. As such, he will not be executing any documents to the contrary. Further, the patent has been assigned to Kim Manufacturing Company. The continuation claims that we filed relating to the jacket are also solely the work of Andrew Marraffa, as he has affirmed. This continuation application is assigned to Kim Manufacturing Company, and any patent relating to the jacket that the USPTO issues will be owned by Kim Manufacturing Company.



Kim Manufacturing Company

BEST AVAILABLE COPY

[REDACTED]

[REDACTED]

[REDACTED]

Best regards,

Thomas J. Kiely
President
Kim Manufacturing Co.

Cc: Counsel, AM , JS
Fn:Rhodes_letter_r5